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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/662,550

09/15/2003

Eric Cosatto

2000-0042Con

2283

26652 7590 10/14/2008
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EXAMINER

HAJNIK, DANIEL F

ART UNIT

PAPER NUMBER

2628

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/662,550</p>	<p>Applicant(s) COSATTO ET AL.</p>	
	<p>Examiner DANIEL F. HAJNIK</p>	<p>Art Unit 2628</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Ulka Chauhan/
Supervisory Patent Examiner, Art Unit 2628

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues:

Applicants note that in our previous response that we argued that Section (a) fails to apply because Section 102(a) requires the invention to be described in a printed publication "before the invention thereof by the Applicant for patent." Applicants note that we provide evidence in the previous Office Action that showed that the subject matter of the present application was reviewed and approved for filing on March 17,2000 according to AT&T's internal review process and assigned to outside counsel. Applicants respectfully submit that there is simply no rebuttal or no discussion of this evidence of an invention date that predated the Cox et al. publication. (bottom of page 2 and top of page 3 in filed response).

The examiner respectfully maintains that the rejections are proper for the following reasons: As explained in the previous final office action, the evidence provided is insufficient to prove prior invention before the date of the publication (Cox et al). As stated on the top half of page 8 in the final action: an affidavit or declaration under 37 CFR 1.131 is required.

MPEP section 715 states:

"37 CFR 1.131. Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based"

The applicant has argued that their evidence proves an invention date that predated the Cox et al. publication. The bottom of page 8 in the final office addresses this and states: "Furthermore, Appendix A filed by applicant may be necessary but is not sufficient to establish that applicant's conceived of the invention prior to the publication of Cox et al.". The top of page 8 further states the requirements for proving prior invention. Thus, the evidence is discussed in the previous final office action.

Further, MPEP section 715 states the following:

"I. SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS CAN BE USED

... (A) To antedate a reference or activity that qualifies as prior art under 35 U.S.C. 102(a) and not under 35 U.S.C. 102(b)"

This appears to be related to the situation in this application.

The evidence provided by the applicant is a single sheet with a date showing the present application reviewed and approved for filing according to AT&T's internal review process and assigned to outside counsel. However, this is not enough according to the requirements as set out by the MPEP. The MPEP has specified guidelines and standards for establishing and providing a prior date for invention, i.e. the filing of an oath or declaration. Another such requirement is: 37 CFR 1.131 (b):

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained

Applicant's evidence thus far has not established the above requirements.

Applicant is encouraged to review the section in MPEP 715 for further details. In general, the Cox et al. reference is assumed to be prior art based upon its date (based upon the 102 statute) until prior invention is proved using the procedures as outlined by the office in the MPEP. Thus, at this time, Cox is prior art under 102(a).

In addition, the applicants argue that the final rejection is premature because:

Notably, even though we previously presented our argument in the context of 35 U.S.C. 5103(c), Applicants certainly note that the foundation of that argument was based upon our position that Cox et al. does not qualify as prior art under Section 102(a) as a printed publication. Therefore, inasmuch as that foundational position has not been adequately addressed or does not appear to have any substantive response in the Office Action

(bottom of page 3 and top of page 4 in remarks)

The examiner maintains that the final office is proper because, as explained above, the evidence was addressed in the final office action on page 8. Also, the examiner addresses this issue of Cox qualifying under prior art under Section 102(a) in the middle of page 7.

Furthermore, it is not clear why the applicants choose not to following the procedures for establishing a prior invention date, as required by the MPEP, from the start (i.e. when the Cox reference was first used in establishing a rejection).